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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,564	06/27/2000	Marco A. DeMello	MSFT-0123/154577.1	5310

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08/11/2004

Peter M Ullman  
Woodcock Washburn Kurtz Mackiewicz & Norris LLP  
One Liberty Place 46th Floor  
Philadelphia, PA 19103

EXAMINER
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BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/604,564

Applicant(s)

DEMELLO ET AL.

Examiner

Christopher J Brown

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16,18-39 and 41-48 is/are rejected.
- 7) ☒ Claim(s) 3, 17, 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4,5,6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. It does not identify the citizenship of each inventor.

It does not include the inventor's signature, or the inventor's signature is in the wrong place.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As per claims 42-48, Claim 42 recites the limitation "first client" in line 6. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, and 4-16, 18-29, 35-36, and 43-44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs US 6,331,865 in view of Herbert US 6,199,053.**

As per claim 1, 11, 15, 21, 27 Sachs discloses a system which validates a server, (Col 3 lines 58-63). Sachs discloses deriving an identifier associated with a computing device (electronic book unique secret key), and uploading said identifier to said server (Col 3 line 63 to Col 4 line 3).

Sachs discloses that the device receives a secure repository from said server, (encrypted content key), (Col 5 lines 2-6).

Sachs does not disclose authenticating said secure repository.

Herbert discloses authenticating data sent over a network through the use of a digital signature, (Col 1 lines 34-45). Herbert teaches that the originator of the data hashes the data and signs the hash with a private key. It turn the receiver decrypts the hash, and compares it with the receivers own hash of the data. If they match, the data has not been tampered with.

It would have been obvious to one of ordinary skill in the art to add the digital signature authentication to the secure repository of Sachs to increase security by providing evidence that the secure repository has not been tampered with.

As per claim 8, 18, Sachs discloses uploading data associated with the user to the server (secret key), Col 4 line 1).

As per claim 9, 19, 23 Sachs discloses the identifier is based on hardware wherein the identifier uniquely identifies the computing device, (secret key) ( Col 3 lines 63-66).

Art Unit: 2134

As per claim 10, 20, Sachs teaches the secure repository (encrypted content key with session key) is based on said identifier, (Col 4 lines 1-8).

As per claim 12, Sachs teaches a dedicated reader device (electronic book), (Col 1, lines 43-46).

As per claim 14 Sachs teaches the address of the server is coded into the device, (Col 7 lines 19-24).

As per claim 24, 25, 35, 36, 43, 44 Sachs discloses the reader may render text, or multimedia data, (Col 1, lines 35-40).

As per claim 26, Sachs discloses the reader device is programmed to contact the server at a predetermined address, (Col 7 lines 19-21).

As per claim 28, Sachs teaches determining whether software is activated (reading purchased test), if it is not activated, Sachs teaches issuing instructions to download a secure repository and use it to allow reading of purchased text, (Col 5 lines 1-14).

As per claim 29, Sachs teaches the secure repository is individualized (encrypted) for the computing device on which the software is installed, (Col 4 lines 60-61).

**Claims 2, 16, 37-39, 45-47, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs US 6,331,865 in view of Herbert US 6,199,053 in view of Rohatgi US 5,625,693.**

Art Unit: 2134

As per claims 2, 16, 37-39, 45-47, The Sachs-Herbert combination teaches encryption of a content key with a public/private key pair, (Col 5 lines 32-40). Sachs-Herbert teaches that content encrypted with a content key may only be decrypted with an unencrypted content key. Sachs-Herbert does not teach exchanging certificates.

Rohatgi teaches sending a certificate with a public private key pair for decryption of content encrypted with the servers private key, (Col 6 lines 33-43).

It would have been obvious to one of ordinary skill in the art to use the certificate with keys from the server to replace the key taught in Sachs-Herbert, because the multiplicity of keys that can be used by the server increases security and prevents any snooper from obtaining a single key.

**Claims 4-7, 13, 30-34, 41, 42, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs US 6,331,865 in view of Herbert US 6,199,053 in view of Eberhard US 2001/0011238.**

As per claims 4-7, 13 the Sachs-Herbert combination does not disclose a client side object.

Eberhard teaches a client-side object in a reader device, as a java applet or plug-in, ([0023, 0024]).

It would have been obvious to one skilled in the art to add the client side object to the reader because of the operability of the applet or plug-in directly with the internet.

As per claim 33, the Sachs-Herbert-Eberhard combination teaches that the software comprises a content rendering application. Eberhard teaches that there may be unencrypted content (first set), allowing content rendering without activation, ([0028]). The Sachs-Eberhard combination teaches rendering of encrypted content (second set), (Col 5 lines 13-16).

As per claim 34, 41, 42, the Sachs-Herbert-Eberhard combination teaches that the software comprises a content rendering application. Eberhard teaches that there may be unencrypted content, allowing content rendering, ([0028]). The Sachs-Eberhard combination teaches rendering of encrypted content, (Col 5 lines 13-16). Sachs-Eberhard thus teaches that a first set may be rendered whether or not a first status is activated (encrypted or unencrypted), while a second set may only be rendered if the first status (encrypted) is activated.

***Allowable Subject Matter***

4. Claims 3, 17, and 40 are objected to due to their dependence on rejected independent claims.


***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100